



UNITED STATES PATENT AND TRADEMARK OFFICE

HN
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,244	11/27/2001	Klaus- Peter Karmann	449122006100	1205
7590	03/09/2005		EXAMINER	
Kevin R Spivak Morrison & Foerster 2000 Pennsylvania Avenue NW Washington, DC 20006-1888				KIM, JUNG W
		ART UNIT		PAPER NUMBER
		2132		

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/889,244	KARMANN, KLAUS- PETER	
Examiner	Art Unit	
Jung W Kim	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 November 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/13/01</u> .	6) <input type="checkbox"/> Other: ____.

DETAILED ACTION

1. Claims 1-4 have been examined. A preliminary amendment was filed on November 27, 2001.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy is included in the instant application.

Information Disclosure Statement

3. The information disclosure statement filed August 13, 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fingerprint mounted at a position on the housing surface at which a finger can easily be place permanently on the sensor when the user's hand is in a normal posture, and wherein the device repeatedly asks for authentication over the course of time of a cost-incurring use event

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The amendment filed November 27, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "One having

ordinary skill in the art will recognize that this invention is not limited to mobile telephones, but may also be applied to any mobile or non-mobile device such as a PDA, WAP, etc." Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. The limitation "which a finger can easily be placed permanently" in claim 3 is a relative term which renders the claim indefinite. The limitation "which a finger can easily be placed permanently" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The mounting of the fingerprint sensor is rendered indefinite by the use of this limitation.
9. The limitation "normal posture" in claim 3 is a relative term which renders the claim indefinite. The limitation "normal posture" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

invention. The placement of the user's hand is rendered indefinite by the use of this limitation.

10. The limitation "without any active involvement" in claim 3 is a relative term which renders the claim indefinite. The limitation "without any active involvement" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The user's action is rendered indefinite by the use of this limitation.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4 are rejected under 35 U.S.C. 102(a) as being unpatentable by Bailey U.S. Patent No. 6,175,923 (hereinafter Bailey).

13. As per claims 1-4, Bailey discloses a communication terminal having a device which, in the terminal's ready-to-receive condition, asks the user for authentication before a cost-incurring use event is initiated; in which the user is authenticated using a fingerprint sensor before a cost-incurring use event is initiated; in which the fingerprint

sensor is mounted at a position on the housing surface at which a finger can easily be placed permanently on the sensor when the user's hand is in a normal posture, so that a series of repeated authentication operations in the case of a series of a plurality of cost-incurring use events can also take place without any active involvement of the user; and having a device which repeatedly asks for authentication over the course of time of a cost-incurring use event. See Bailey, Figure 1; col. 1:12-33; 2:4-17; claims 1 and 2. The aforementioned cover the limitations of claims 1-4.

14. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being unpatentable by Hsu U.S. Patent No. 6,041,410 (hereinafter Hsu).

15. As per claims 1-4, Hsu discloses a communication terminal having a device which, in the terminal's ready-to-receive condition, asks the user for authentication before a cost-incurring use event is initiated; in which the user is authenticated using a fingerprint sensor before a cost-incurring use event is initiated; in which the fingerprint sensor is mounted at a position on the housing surface at which a finger can easily be placed permanently on the sensor when the user's hand is in a normal posture, so that a series of repeated authentication operations in the case of a series of a plurality of cost-incurring use events can also take place without any active involvement of the user; and having a device which repeatedly asks for authentication over the course of time of a cost-incurring use event. See Hsu, Figures 1 and 4; col. 1:53-57; 3:48-55; 6:35-7:43. The aforementioned cover the limitations of claims 1-4.

16. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being unpatentable by Li et al. International Publication Number WO 98/11750 (hereinafter Li).

17. As per claims 1-3, Li discloses a communication terminal having a device which, in the terminal's ready-to-receive condition, asks the user for authentication before a cost-incurring use event is initiated; in which the user is authenticated using a fingerprint sensor before a cost-incurring use event is initiated; in which the fingerprint sensor is mounted at a position on the housing surface at which a finger can easily be placed permanently on the sensor when the user's hand is in a normal posture, so that a series of repeated authentication operations in the case of a series of a plurality of cost-incurring use events can also take place without any active involvement of the user.

See Li, Figure 1 and related text. The aforementioned cover the limitations of claims 1-3.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Stallings Cryptography and Network Security (hereinafter Stallings).

20. As per claim 4, the 102(b) rejections of claims 1-3 as outlined above under Li are incorporated herein. In addition, Li teaches using challenge-response techniques combined with fingerprint biometric scanning to authenticate a user, but does not expressly teach repeatedly asking for authentication over the course of time of a cost-incurring use event. Stallings discloses repeatedly authenticating a user by means of a challenge/response technique to prevent replay attacks. See Stallings, pg. 304, 5th bullet. It would be obvious to one of ordinary skill in the art at the time the invention was made for the device to repeatedly ask for authentication over the course of time of a cost-incurring use event to prevent replay attacks as taught by Stallings, *ibid*. The aforementioned cover the limitations of claim 4.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hsu et al. U.S. Patent No. 6,038,666 discloses a finger biometric enrollment fob device.

Gressel U.S. Patent No. 6,311,272 discloses a biometric authentication method and system using enrollment templates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim
Examiner
Art Unit 2132

Jk
March 3, 2005



GILBERTO BARRON JN.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100